

REMARKS

Upon entry of the amendments, claims 1-11, and 13-22 will be pending in the present application. Claims 1, 10, 11 and 20 have been amended and new claims 21 and 22 have been added. Applicants submit that the amendments and new claims are supported throughout the specification as originally filed, and therefore, no new matter is added. Claim 12 has been cancelled without prejudice or disclaimer.

For sake of clarity, Applicants point out that the amendments to the claims under 37 CFR §1.116 submitted in Applicants response filed October 12, 2006 were denied entry pursuant to the Advisory Action mailed October 27, 2006. As such, the current status of the claims is reflected in the listing of the claims filed herewith.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-20 have been rejected as unpatentable over Bianco *et al.* (US 2002/0092965) in view of McMenimen *et al.* (US 2002/0077850) under 35 U.S.C. § 103 (a).

As Applicants have previously made of record, neither Bianco *et al.* (US 2002/0092965) nor McMenimen *et al.* (US 2002/0077850) qualify as prior art under 35 U.S.C. § 102 because both references were filed after the filing date of the present application. The Examiner has cited provisions of the McMenimen priority document (McMenimen U.S. Appl. No. 60/180,289), but the Examiner continues to cite to Bianco *et al.* (US 2002/0092965), which is not prior art.

Applicants have previously pointed out that it is the USPTO, and not the Applicant, that bears the initial burden of establishing *prima facie* obviousness. Establishing a case of *prima facie* obviousness includes that the Examiner, *inter alia*, identify each and every element of the claims in the prior art. See, e.g., MPEP §2142, 2143. As such, the Examiner has failed to establish *prima facie* obviousness at least for failing to factually support the allegation that each and every element of the presently claimed invention is found in the prior art.

Nevertheless, the Examiner continues to argue that *prima facie* obviousness has been established because "[t]he Examiner has specifically laid out which excerpts of the cited references are pertinent to the claimed invention and has set forth motivation for combining the cited teachings, as seen in the art rejection." (Advisory Action, mailed 10/27/2006; emphasis added). However, the Examiner continues to disregard that fact that "the cited references" include documents filed after the filing date of the present application and, therefore, are **not prior art**, as indicated above. Thus, the Examiner has failed to support the allegation that each and every element of the current claims are taught or suggested in the prior art, thereby precluding *prima facie* obviousness.

Therefore, Applicants submit that the rejections should be withdrawn at least for the reasons set forth above or, if the rejections are not withdrawn, that the Examiner specifically identify teachings in McMenimen U.S. Appl. No. 60/180,289 or Bianco U.S. Appl. No. 60/212,576 that would support the position that each and every element of the currently claimed invention are found in these references.

While the rejection is traversed for the reasons set forth above, Applicants will address the rejections as they may apply to Bianco U.S. Appl. No. 60/212,576 (hereafter "Bianco") and McMenimen U.S. Appl. No. 60/180,289 (hereafter "McMenimen"), in order to be fully responsive to the Office action. While Applicants do not concede these priority documents as prior art, they are addressed herein as the respective filing dates predate the filing date of the present application.

Although Applicants respectfully disagree with the rejections and do not acquiesce to any reasoning provided by the Examiner, claims 1, 10, 11 and 20 have been amended in order to clarify certain differences between the present invention and the cited references, and in order to expedite prosecution of the present case. Claim 12 has been canceled without prejudice or disclaimer and claims 21 and 22 have been added. Applicants respectfully submit that the cited references, either alone or in combination, fail to teach or suggest each and every element of the presently claimed invention, thereby precluding *prima facie* obviousness.

Bianco is directed to an on-line guide to help patients recover from major medical procedures. However, Bianco fails to teach a server that is configured to automatically communicate manufacturing progress information with a patient's computer or to perform patient scheduling when one or more dental appliances reach a predetermined manufacturing progress, as recited in claim 1. Nowhere does Bianco address dental products or teach monitoring a manufacture process of any product whatsoever, and Bianco certainly does not teach coordinating dental product manufacture with patient scheduling with an orthodontic professional.

In fact, Bianco is, at best, ambiguous with respect to the scheduling functionality of the system taught in the provisional application. While the Bianco provisional application makes reference to calendaring features and adding/deleting appointments/tasks to a calendar (e.g., pages 30-31 of Bianco), it is unclear whether the system of Bianco is configured for any scheduling function other than merely calendaring appointments/tasks and/or reminders to the patient to conduct the scheduling activity themselves.

In response to Applicants previous remarks, the Examiner cites to paragraphs 108 and 121 of the later filed Bianco *et al.* (US 2002/0092965) as teaching providing a patient with an interview to actively schedule an appointment through a server. As set forth above, however, Bianco *et al.* (US 2002/0092965) is not prior art and, therefore, irrelevant to the examination of the present application.

McMenimen does not cure the deficiencies of Bianco. McMenimen does not even address patient scheduling, but instead is directed to an interactive manufacturing system for medical devices in which a manufacturing server interacts with data centers to collect information for various build-to-order scenarios. The system of McMenimen requires the patient/ordering entity to actively monitor, presumably after actively logging onto or otherwise actively engaging/prompting the McMenimen system or third party system, in order to check the shipment delivery status, etc. The McMenimen system only provides information to a user where the user actively engages the system and prompts the system to provide the information. Thus, in the absence of being prompted by the user, the system of McMenimen does not

communicate the information to the user. Thus, McMenimen does not teach automatically communicating or sending a message to the patient regarding manufacturing progress information (e.g., in the absence of the patient prompting the system for the desired information), including when dental appliances reach a predetermined manufacturing progress.

Even if, for arguments sake only, one were to attempt to combine the references by employing the scheduling reminders taught by Bianco with the delivery status, etc. monitoring function of McMenimen (even though there appears to be no motivation to do so), the combination would appear to be limited to merely sending scheduling reminders that are not integrated with manufacturing and completely unrelated to manufacturing progress. Furthermore, the proposed combination would still require the patient to actively monitor the manufacture progress themselves and actively prompt the McMenimen system for the desired information, as McMenimen 's approach merely allows patients/ordering entities to monitor shipment delivery status, etc., such as by monitoring a third party's website (e.g., FedEx). The proposed combination would still not teach a server configured to automatically communicate manufacturing progress information (e.g., in the absence of the patient prompting the server for the information) with the patient computer and to perform patient scheduling when one or more dental appliances reach a predetermined manufacturing progress, as recited in claim 1.

Dependent claims 2-10 are allowable at least for depending from allowable independent claim 1. Claim 12 has been canceled without prejudice. Dependent claims 13-19 are allowable at least for depending from allowable independent claim 11.

Accordingly, for the reasons set forth above, Applicants respectfully request the withdrawal of the rejections of claims 1-11 and 13-20 under 35 U.S.C. § 103(a).

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Application No. 09/621,716
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3623

PATENT

CONCLUSION


In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Date: _____

11/13/2000



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